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| 10/073,115 | 02/12/2002 | Shuang Chu Tsai | | 2330 |

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EXAMINER

MUSSER, BARBARA J

| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,115

Applicant(s)

TSAI, SHUANG CHU

Examiner

Barbara J. Musser

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether one or two elastomers are formed as the claim states forming the elastomer and the gasbag and then trimming and then states forming them in more detail again. It is suggested that line 2 of claim 1 be removed. It is unclear whether the first face and the second face of the elastomer are formed during the injection molding or if there is shaping afterwards as the claim indicates the insert is formed, then indicates the first and second faces are formed. It is unclear when the holes are formed in the elastomer. In line 8, it is unclear what is occurring. While "the injection molder" does not lack antecedent basis, the injection molder feeding the plastic film is not the injection molder which forms the elastomer. It is suggested this be described as "another injection molder" or "a second injection molder". It is unclear what air is being removed in line 12 as the claim does not disclose whether vacuum is applied to the interior or exterior of the plastic film particularly since the claim indicates air is still present after the vacuum is applied.

Claim 1 recites the limitation "the cylindrical plastic film or plastic sheet" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 2, it is unclear whether one gasbag is produced at a time or more are. It is suggested the second "gasbags" in line 2 be changed to --gasbag--.

Claim Objections

3. Claim 2 is objected to because of the following informalities: in claim 2, line 3, proper English indicates "enveloping" should be --envelop--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diaz et al.(U.S. Patent 5,005,300) in view of McLaughlin(U.S. Patent 5,979,078), Hopperdietzel(U.S. Patent 4,911,878), Pavesi et al.(U.S. Patent 5,987,781), and Luthi(U.S. Patent 5,461,800)

Diaz et al. discloses an elastic pad for a shoe sole made of an elastomer having holes running parallel to the top and bottom faces which are open to the outside.(Figure 6; Abstract) The reference discloses holes can be closed but to does specify how other than that the elastomer can cover them.(Col. 5, ll. 63-67) McLaughlin discloses it is known in the shoe insert art to form enclosed areas in the insert by surrounding the

Art Unit: 1733

insert but the reference does not disclose the specifics of the formation of the outer bladder(gasbag) only that it is welded around the inner.(Col. 1, ll. 29-46; Figures 3 and 5)

Hopperdietzel discloses forming a reinforcement for athletic equipment(Col. 2, ll. 64) by placing the reinforcement on a positioning rod and placing it between the two halves of a mold. Material is extruded as a tubular preform around the reinforcing member.(Col. 5, ll. 6) The mold is then closed and the gas forced between the reinforcement and the extruded material, forcing the material against the mold walls. The positioning rod is withdrawn and the product is formed.(Figure 3; Col. 5, ll. 32-66) It would have been obvious to one skilled in the art at the time the invention was made to form the shoe insert of Diaz et al. via the method of Hopperdietzel since this would prevent the insert from moving around inside the gasbag(Col. 2, ll. 1-3) particularly since Pavesi et al. discloses it is known to have open ended reinforcing elements within a sealed shoe insert.(Figure 4; Col. 4, ll. 37-39)

The reference cited above do not disclose how the elastomeric insert is formed. Luthi discloses it is known to form elastomeric inserts for shoes which have openings running longitudinally by injection molding.(Col. 3, ll. 40-44) It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the insert of Diaz et al. by injection molding since Diaz et al. is silent as to the method of formation and since Luthi et al. discloses it is known to form elastomeric inserts for shoes by injection molding.(Col. 3, ll. 40-44)

While the reference does not require vacuum to pull the material against the mold walls, such is well-known and conventional in the molding arts. It would have been obvious to one skilled in the art at the time the invention was made to use vacuum to pull the material against the mold walls in addition to pressing them with air since such is well-known and conventional in the art.

While Hopperdietzel intends the positioning rod to be removed from the mold, one in the art would appreciate that the rod could instead form a portion of the final product. It would have been obvious to one skilled in the art at the time the invention was made to make the positioning rod part of the final product to prevent the difficulties with removing it during the process.

Although Hopperdietzel does not specifically disclose trimming the margins of the outer bladder, Figure 5 shows material external to the mold which is not shown in the final product.(Figures 8-10) Thus one in the art would understand that the outer bladder was trimmed to remove excess material.

Regarding claim 2, McLaughlin discloses a formed periphery for the outer bladder.(Figure 2) The layers are pressed together via the mold.(Col. 6, ll. 3-6) One in the art would appreciate that the mold edges would be heated to insure the edges formed a secure bond.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is (703)-

Art Unit: 1733

305-1352 until December 20 when it changes to (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BJM

BJM

Jeff H. Aftergut
JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300